REMARKS

Claims 4-12 and 14-16 are now in the application. By this Amendment, claims 4-6 and 14-16 have been amended. Support for the amendments is found at least at original claims 4 and 5. No new matter has been added.

Claims 4 and 5 have been objected to because they do not end with a period. Claims 4 and 5 have been amended to obviate this objection.

Claims 4 and 5 have been rejected under 35 U.S.C. §112, first paragraph, because the feature "0.05-50 milligrams/kg of body weight" is not described in the application as filed. These features have been inadvertently introduced in the November 2, 2006 Amendment. By this Amendment, the claims have been amended to recite "0.1-100 milligrams/kg of body weight" as recited in original claims 4 and 5.

Claims 4-12 and 14-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,547,942 to Rapaport in view of U.S. Patent No. 5,422,352 to Astrup.

Claims 4-6 recite, among other features, a method for obtaining weight loss in humans by administering caffeine or theophylline and administering an adenosine compound. Claims 14-16 recite, among other features, a method for maintaining weight reduction in humans by administering caffeine or theophylline and administering an adenosine compound. At least these features of the independent claims cannot reasonably be considered to be suggested by the applied citations.

Astrup suggests, at col. 4, lines 61-66, that a synergistic effect is achieved by administering caffeine and ephedrine. In other words, Astrup suggests ephedrine as an essential compound for the treatment disclosed therein. The independent claims, reciting that weight loss is caused by administering the first member and the second member or weight reduction is maintained by administering the first member and the second member, specifically exclude ephedrine because ephedrine is not recited as causing weight loss. Further, Applicant described in the November 29, 2007 Response to a previous Office Action the severe health implications

caused by ephedrine and the final rule issued by the Food and Drug Administration prohibiting the sale of dietary supplements containing ephedrine alkaloids (ephedra).

In fact, the U.S. Patent and Trademark Office acknowledged in the prosecution of U.S. Patent Application No. 10/140,189, in which priority document WO 01/28528 was cited, that this application claims a method wherein weight loss is caused by administering an adenosine compound along with caffeine or theophylline.

Further, the Office Action made an insufficient showing for a motivation to combine Rapaport and Astrup. The October 25, 2007 Office Action asserted: "However, Astrup teaches compositions comprising caffeine and ephedrine for the purpose of reducing weight of a human (Abstract). With regard to diabetes mellitus as taught in Rapaport, Astrup teaches that obesity is accompanied by a number of health hazards such as diabetes mellitus, which is more common in overweight people than in individuals of normal weight (col.1, lines 36-45). Thus obesity is taught to contribute to morbidity and mortality in individuals suffering from e.g. diabetes mellitus (id. At lines 45-48). Astrup thus teaches a method of treating complications to overweight or obesity such as diabetes mellitus..."

Applicant respectfully submits that treating complications to overweight or obesity has nothing to do with suggesting the treatment of overweight or obesity themselves. There are many clinical complications to overweight or obesity, diabetes mellitus (type II diabetes) being just one of them. Frank type II diabetes happens only in a small fraction of overweight or obese individuals. A larger fraction suffer from glucose insensitivity. However, the vast majority of overweight or obese individuals do not suffer from either glucose insensitivity or frank type II diabetes. They are at risk for developing these clinical complications at a later date. Therefore, the compositions of Astrup or the treatments in Rapaport are unrelated to overweight or obesity but are rather directed strictly at type II diabetes. In other words, since there are 66% of the population overweight and only a maximum of 7.8% with diabetes, the treatment of diabetes can not suggest a treatment of obesity or overweight.

Claims 4-12 and 14-16 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 5,547,942 to Rapaport in view of U.S. Patent No. 5,422,352 to Astrup.

Applicant respectfully submits that a nonstatutory obviousness-type double patenting rejection over a combination of citations is improper per se and fails to comply with the applicable rules and regulations. Specifically, a nonstatutory obviousness-type double patenting addresses a situation in which a claim or a group of claims are rejected over a claim or a group of claims in another application or patent. Here, the Office Action attempts to reject the pending claims over a combination of citations, which, alone or in combination, do not claim the combination of all of the features of the pending claims in this application. The Office Action even acknowledges, at page 6, third paragraph, that in a double patenting rejection an application is asserted to conflict with another application or patent, i.e., with one other citation. Having to rely on two citations, the Office Action acknowledges that neither citation by itself suggests the combination of all of the features of independent claim 4. Thus, this rejection has been made in error.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21095-00008-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

Electronic signature: /Georg M. Hasselmann/
Georg M. Hasselmann
Registration No.: 62,324
CONNOLLY BOVE LODGE & HUTZ LLP
1875 Eye Street, NW
Suite 1100
Washington, DC 20006
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant